

REMARKS

Applicants have carefully considered the decision on Appeal by the Honorable Board of Patent Appeals and Interferences mailed August 17, 2005, and the amendments above together with the comments that follow are presented in a bona fide effort to address the new ground of rejection set forth in the Board decision and thereby place this case in condition for allowance. Claims 1, 3, 8-10, 19, 24, 25, and 30 were pending on Appeal and claims 1, 3 and 9 were newly rejected by the Board.

In response to the Board's decision, claims 1, 8, 10 and 18 have been amended and new claim 88 has been added. Care has been exercised to avoid the introduction of new matter. Adequate descriptive support for the present Amendment should be apparent throughout the originally filed disclosure as, for example, the depicted embodiments and related discussion thereof in the written description of the specification. Applicants submit that the present Amendment does not generate any new matter issue. Entry of the present Amendment is respectfully solicited. It is believed that this response places this case in condition for allowance. Hence, prompt favorable reconsideration of this case is solicited.

The Board rejected independent claim 1 and dependent claims 3 and 9 under 35 U.S.C. § 103(a) as being unpatentable over Walker in view of Vancura, Martinez or Kilby. Applicants respectfully submit that independent claim 1, as well as newly added independent claim 88, are free from the applied art.

Walker is silent as to a combined knowledge-based bonus game with the underlying game of chance having a house advantage within a predetermined range. Moreover, the secondary references merely teach the basic operational concepts of the

casino and casino games and the need for the generation of an advantage to the house so as to generate operational income and a profit.

None of the applied references, alone or in combination, discloses or remotely suggests the subject matter of independent claims 1 and 88. Independent claim 1 has been amended to clarify that the house advantage is within a predetermined range and is dependent upon the knowledge of a particular player. Thus, claim 1 requires that the predetermined house advantage is dependent upon (i.e. variable) the knowledge of a particular player. Moreover, new claim 88 describes, in pertinent part, the steps of playing an underlying game of chance and delivering payoffs, if any, in the underlying game of chance. Thus, claim 88 requires not only that the house advantage is within a predetermined range, but requires the step of delivering payoffs (i.e. a payout), if any, in the underlying game of chance. Dependent claims 3 and 9 are free from the applied art in view of their dependency from claim 1.

Claims 8, 10 and 18, which were not rejected by the Board, have been recast in independent form and are believed to be in condition for allowance. Claims 19, 24, 25 and 30 were not rejected by the Board and are believed to be in condition for allowance.

It is believed that claims 1, 3, 8, 9, 10, 18, 19, 24, 25, 30 and 88 are now in condition for allowance. Applicants therefore respectfully request an early and favorable reconsideration and allowance of this application. If there are any outstanding issues which might be resolved by an interview or an Examiner's amendment, the Examiner is invited to call Applicants' representative at the telephone number shown below.

To the extent necessary, a petition for an extension of time under 37 C.F.R. 1.136 is hereby made. Please charge any shortage in fees due in connection with the filing of

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this paper, including extension of time fees, to Deposit Account 500417 and please credit any excess fees to such deposit account.

Respectfully submitted,

McDERMOTT WILL & EMERY LLP

A handwritten signature in black ink, appearing to read "Brian K. Seidleck".

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